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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/932,369	08/17/2001	David A. Estell	GC626-2	4880

5100 7590 06/03/2003

GENENCOR INTERNATIONAL, INC.  
ATTENTION: LEGAL DEPARTMENT  
925 PAGE MILL ROAD  
PALO ALTO, CA 94304

EXAMINER

COUNTS, GARY W

ART UNIT	PAPER NUMBER
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1641

DATE MAILED: 06/03/2003

114

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/932,369

Applicant(s)

ESTELL ET AL.

Examiner

Gary W. Counts

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-33 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other:

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1, 2, 5-10 and 13-15, drawn to a method for determining the absolute quantity of a target biopolymer, classified in class 435, subclass 6.
  - II. Claims 19-21, 24, and 27 drawn to a method for verifying the presence and, optionally, determining the absolute quantity of a selected putative biopolymer in a mixture containing a plurality of isotope-labeled cellular biopolymer from a selected cell type, classified in class 435, subclass 967.
  - III. Claim 28, drawn to a cell culture extract, classified in class 435, subclass 378.
  - IV. Claims 29-33, drawn to a method for determining the identity of a target biopolymer fragment in a solution, classified in class 436, subclass 173.
2. Inventions I and II are independent and distinct inventions. Invention II involves selecting a putative biopolymer potentially present in the mixture and generating a theoretical fragmentation of the putative biopolymer; selecting a theoretical fragment from the theoretical fragmentation; and producing a biopolymer-fragment corresponding to the theoretical fragment and Invention I does not involve these limitations.
3. Inventions I and III are independent and distinct inventions. Invention I is a method for determining the absolute quantity of a target biopolymer in a crude solution

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whereas invention III is a cell-culture extract, derived from a select microorganism grown on media enriched in a specific isotope.

4. Inventions I and IV are independent and distinct inventions. Invention I involves determining by mass spectrometric analysis the ratio of a selected target biopolymer to its corresponding analog whereas Invention IV involves adding an analog of the target biopolymer and the target biopolymer to the solution, in a selected analog:target ratio. Also, invention IV involves determining the biopolymer sequence of the biopolymer-fragment pairs identified by mass spectrometric analysis.

5. Inventions II and III are independent and distinct inventions. Invention II is a method for verifying the presence and, optionally, determining the absolute quantity of a selected putative biopolymer whereas invention III is a cell-culture extract, derived from a select microorganism grown on media enriched in a specific isotope.

6. Inventions II and IV are independent and distinct inventions. Invention II involves selecting a putative biopolymer potentially present in the mixture and generating a theoretical fragmentation of the putative biopolymer; selecting a theoretical fragment from the theoretical fragmentation; and producing a biopolymer-fragment corresponding to the theoretical fragment and Invention IV does not involve these limitations. Also, Invention IV involves adding an analog of the target biopolymer and the target biopolymer to the solution, in a selected analog: target ratio and Invention II does not require this limitation.

7. Inventions III and IV are independent and distinct inventions. Invention III is a cell-culture extract, derived from a select microorganism grown on media enriched in a

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specific isotope whereas invention IV is a method for determining the identity of a target biopolymer fragment in a solution.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and the search required for one group is not required for other restriction for examination purposes as indicated is proper.

This application contains claims directed to the following patentably distinct species of the claimed invention: biopolymers in claims 2 and 21; claims 3, 4, 11-12, 16-18 and claims 22, 23, 25 and 26 includes limitations dependent upon which species in claims 2 and 21-23 is finally elected by Applicant:

A). polynucleotides

B). polypeptides

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 2, 5-10, 13-15, 19-21 24 and 27 are generic. Claims 3, 4, 11-12, 16-18, 22, 23, 25 and 26 are subject to species election.

Applicant is advised that a reply to the requirement must include an identification of the species that is elected consonant with the requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

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Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 DFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

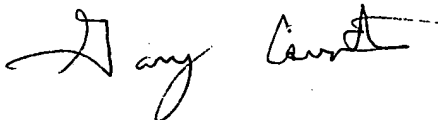
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary W. Counts whose telephone number is (703) 305-1444. The examiner can normally be reached on M-F 8:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on (703) 305-3399. The fax phone numbers for

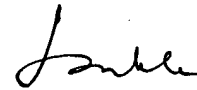
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the organization where this application or proceeding is assigned are (703)308-4242 for regular communications and (703)3084242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.



Gary W. Counts  
Examiner  
Art Unit 1641  
June 2, 2003



LONG V. LE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600

06/02/03